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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VICTOR S. CHAN,
LEV MIRLAS, and
DANNY YIU

Appeal 2009-014824
Application 10/773,496
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges.*

LORIN, *Administrative Patent Judge.*

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Victor S. Chan et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-7 and 22. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.²

THE INVENTION

This invention is “a generic store profile structure for dynamically managing shared and non-shared content of various stores.” Specification 5:2-3.

Claims 1 and 22, reproduced below, are illustrative of the subject matter on appeal.

1. For a client/server system having at least a client including a graphical user interface to display a content of virtual hosted stores to a user, the virtual stores being stored in databases managed by a database management system in a resource manager, the graphical user interface being operatively connected to an application server having a business logic module to select the content to be displayed, a method of managing the content of the hosted virtual stores comprising the steps of:

creating a profile store which servers as a

² Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Mar. 24, 2009) and Reply Brief (“Reply Br.,” filed Jul. 20, 2009), and the Examiner’s Answer (“Answer,” mailed May 29, 2009).

template and upon which the hosted stores are formatted;

designating one or more e-marketing spot in the hosted stores;

setting up a marketing campaign for the hosted stores; and

creating one or more campaign initiatives in the profile store for the content to be displayed in the hosted stores.

22. A method for populating campaign initiatives, the method comprising the steps of:

accessing a list of pre-defined e-marketing spots for a profile store;

creating an e-marketing spot for said profile store by selecting said e-marketing spot from said list of pre-defined e-marketing spots;

accessing a first list of pre-defined campaign initiatives for said profile store;

creating a campaign initiative for said hosted store by selecting said campaign initiative from said second list of campaign initiatives;

accessing a second list of campaign initiatives for a hosted store;

creating a campaign initiative for said hosted store by selecting said campaign initiative from said second list of campaign initiatives;

selecting said e-marketing spot created for said profile store to an e-marketing spot in said hosted store;

scheduling said campaign initiative created for said profile store to said e-marketing spot in said hosted store;

scheduling said campaign initiative created for said hosted store to said e-marketing sport in said hosted store; and

rejecting said scheduling of said campaign initiative created for said hosted store if there is a

conflict between said campaign initiative created
for said profile store and said campaign initiative
created for said host store.

THE REJECTIONS

The Examiner relies upon the following as evidence of
unpatentability:

| | | |
|----------|-----------------|---------------|
| Ozer | US 7,136,871 B2 | Nov. 14, 2006 |
| Westrope | WO 01/29716 A2 | Apr. 26, 2001 |

The Examiner took official notice that “such decision are old and well
known within the advertising arts” when referring to an operator making a
decision between which advertisement would have priority. Answer 6-7.
[Hereinafter, Official Notice.]

The following rejections are before us for review.

1. Claims 1-7 and 22 are rejected under 35 U.S.C. §101 because
the claimed invention is directed to non-statutory subject
matter.
2. Claims 1-4 and 7 are rejected under 35 U.S.C. §102(b) as being
anticipated by Westrope.
3. Claims 5, 6, and 22 are rejected under 35 U.S.C. §103(a) as
being unpatentable over Westrope, Ozer, and Official Notice.

ISSUES

The first issue is whether the Examiner erred in finding that claims 1-
7 and 22 are directed to non-statutory subject matter under 35 U.S.C. § 101.

The second issue is whether claims 1-4 and 7 are anticipated by Westrope under 35 U.S.C. § 102(b). Specifically, the issue is whether the Examiner's construction of "profile store" is unreasonably broad. The rejection of claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Westrope, Ozer, and Official Notice also turns on this issue.

The third issue is whether claim 22 is unpatentable under 35 U.S.C. § 103(a) over Westrope, Ozer, and Official Notice. Specifically, the issue is whether the cited passages teach the steps of "accessing a first list of pre-defined campaign initiatives for said profile store; creating a campaign initiative for said profile store by selecting said campaign initiative from said first list of campaign initiatives," as well as, the steps of "accessing a second list of campaign initiatives for a hosted store; creating a campaign initiative for a hosted store by selecting said campaign initiative from said second list of campaign initiatives."

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Specification's page 6, lines 19-20 state "the computer program product comprising: (a) code for creating a profile store which serves as a template and upon which hosted stores are formatted."
2. Westrope's page 8, line 15 thru page 9, line 14 describes a docket template interface 104 which a creator can use to create an

advertisement and which includes the ability to select advertising content from a standard list.

ANALYSIS

The rejection of claims 1-7 and 22 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

The Examiner rejected claims 1-7 and 22 under 35 U.S.C. § 101 as being directed to non-statutory subject matter because the method is not tied to a particular machine or apparatus nor does the method transform a particular article into a different state or thing. Answer 3. The Examiner seems to have found that these claims fail the machine-or-transformation test. Answer 3-4.

Notwithstanding that this test for determining patent eligibility of a process is unduly narrow (*see Bilski v. Kappos*, 130 S. Ct. 3218, No. 08-964, 2010 WL 2555192 (U.S. June 28, 2010)), it can nevertheless be instructive as a factor in determining whether the claimed processes are patent-ineligible abstract ideas.

Before we can determine whether the claimed processes are abstract ideas, the broadest reasonable construction of the claims must first be established. *See State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 1370 (Fed. Cir. 1998) (“whether the . . . patent is invalid for failure to claim statutory subject matter under 35 U.S.C. § 101[] is a matter of both claim construction and statutory construction”). In that regard, the both claims 1 and 22 recite “hosted stores,” which reasonably construed seems to implicitly require a host, which would require a particular apparatus.

The Examiner finds that the claimed processes are not tied to another statutory class of invention, such as a machine. But the Examiner does not explain why this is so. *See* Answer 3-4. An explanation is made more necessary, given that the claims are reasonably broadly construed to require a particular apparatus. That is, they are nominally tied to a particular apparatus in contradistinction to the Examiner's finding. The initial burden of establishing that the claimed processes are patent-ineligible abstract ideas has not therefore been established because the construction of the claims does not fully support finding that they are not tied to an apparatus as an underlying factor in concluding that the processes as claimed as a whole are patent-ineligible abstract ideas.

Accordingly, we find that the rejection of claims 1-7 and 22 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is overcome.

The rejection of claims 1-4 and 7 under 35 U.S.C. §102(b) as being anticipated by Westrope.

Claim 1 recites "creating a profile store which servers as a template and upon which the hosted stores are formatted." The Examiner's and the Appellants' dispute centers on whether the claimed "profile store" reads on Westrope's "presentation layout templates 308." Answer 9-10 and App. Br. 6-8. The Examiner states:

A profile store is a template as defined by the [A]ppellant's specification on page 6, lines 19-20. The Examiner notes that Westrope discloses on page 9, lines 1-4, creating templates, templates to which the appellant as clearly stated that the profile stores are templates. Also the [A]ppellant used the term profile store, however does not

disclose in the specification nor in the claims that the profile store is selling a product or service.

The profile store has been disclosed in claim 1 to be a template . . .

Answer 10. The Examiner seems to be broadly construing the profile store to be any template.

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003). “The question then is whether the PTO’s interpretation of the disputed claim language is “reasonable.”” *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997).

We find that the Examiner has unreasonably broadly construed the claimed step of creating a profile store to encompass creating any template. We find nothing in the Specification on page 6, lines 19-20 (*see* FF 1) that

defines “profile store” to be *any* template, but only a description of the function of the profile store, which is to “serve as a template.” Given that we find that the Examiner has erred in construing the term “profile store”, we agree with the Appellants that “[c]reating an advertisement is not creating a profile store.” App. Br. 7. We note that a definition of “store” is “a business establishment where usu. diversified goods are kept for retail sale.” *See Merriam-Webster’s Collegiate Dictionary* 1159 (10th Ed. 1998).

The Examiner erred in rejecting claim 1 by unreasonably broadly construing the step at issue. Accordingly, we find that the Appellants have overcome the rejection of claims 1-4 and 7 under 35 U.S.C. § 102(b) as being anticipated by Westrope.

The rejection of claims 5, 6, and 22 under 35 U.S.C. §103(a) as being unpatentable over Westrope, Ozer, and Official Notice.

Claims 5 and 6

As to claims 5 and 6, these rejections are directed to claims dependent on claim 1, whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claims 5 and 6 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.”). We note that the Examiner did not cite Ozer or Official Notice to teach the limitation at issue with regard to Westrope above, but relied upon the same interpretation of Westrope. *See Answer 5-7.*

Claim 22

Claim 22 recites: “accessing a first list of pre-defined campaign initiatives for said profile store; creating a campaign initiative for said profile store by selecting said campaign initiative from said first list of campaign initiatives” and “accessing a second list of campaign initiatives for a hosted store; creating a campaign initiative for a hosted store by selecting said campaign initiative from said second list of campaign initiatives.” To teach these limitations, the Examiner cites to page 8, lines 15-20 and pages 9, lines 1-14 of Westrope. Answer 7-8. The Appellants and the Examiner dispute whether the cited passages teach these limitations. *See* App. Br. 20-21, Reply Br. 5-6, and Answer 16.

We agree with the Appellants that the cited passages do not teach both accessing and selecting from a *first* list of predefined campaign initiatives for a profile store and accessing and selecting from a *second* list of predefined campaign initiatives for a hosted store. *See* App. Br. 20-21. While these passages do describe selecting elements of an advertisement from lists (*see* FF 2), these passages do not teach accessing and selecting from a first list of predefined campaign initiatives for a profile store, as well as, accessing and selecting from a second list of predefined campaign initiatives for a hosted store. We note that the Examiner provides no explanation other than asserting that these steps are taught by the cited passages and that the Examiner did not cite Ozer or Official Notice to teach these steps. *See* Answer 7-8 and 12-13. Accordingly, we find that the Appellants have overcome the rejection of claim 22 under 35 U.S.C. §103(a) as being unpatentable over Westrope, Ozer, and Official Notice.

Appeal 2009-014824
Application 10/773,496

DECISION

The decision of the Examiner to reject claims 1-7 and 22 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

REVERSED

mev

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